

REMARKS

I. PENDING CLAIMS AND SUPPORT FOR AMENDMENT

New claims 96-124 are directed to methods of facilitating administration of a bioactive to the human body (claims 96-104), methods for treating cachexia in cancer patients (claims 105-113), and compounds and compositions suitable for use in the above methods (claims 114-124). The new claims are fully supported by the specification and claims as originally filed. No new matter has been added.

II. WITHDRAWAL OF NONELECTED CLAIMS

Applicants note that the Examiner has, in the past, withdrawn from consideration claims to compositions and methods of use, and respectfully request that the Examiner not repeat this withdrawal with regard to the claims added by the present application, since if the compounds are found to be allowable, then compositions containing them and methods of using them must also, by definition, be allowable.

III. REJECTION UNDER 35 U.S.C. 112, SECOND PARAGRAPH

The present claims do not use the terminology “comprises” as objected to by the Examiner.

The terminology “other difunctional acid linking moiety” is not indefinite, as alleged by the Examiner, and fully complies with the requirements of 35 U.S.C. 112, second paragraph. When this terminology is considered in the context of the structural formula in the claims, as well as in light the specification, it is clear that the claim reads on compounds meeting the limitations of the independent claims, and

having a linking moiety between R¹ and the corresponding diol oxygen, or between R² and the corresponding diol oxygen, or both, and that this linking moiety is a difunctional acid. A worker of skill in the art would readily be able to determine whether a particular compound meets the limitations of the claims including the above terminology. Accordingly, the claims are clear and definite in accordance with the requirements of 35 U.S.C. 112. *See In re Miller*, 169 USPQ 597 (CCPA 1971).

The Examiner's rejection under 35 U.S.C. 112, second paragraph, is therefore traversed, and reconsideration is respectfully requested.

IV. REJECTION UNDER 35 U.S.C. 103(a)

The Examiner argues that EP 0161114 discloses compounds that are "homologs, isomers, or close structural analogs of the claimed compound," and specifically points to Example 1, page 4, Figures 1 to 6, and Table 5 of the EP publication as supporting his assertion.

As previously explained to the Examiner, none of the esters disclosed in the '114 publication fall within the scope of the present claims. Nor would a worker of ordinary skill in this art have been motivated to modify the esters disclosed in the '114 publication in such a way as to obtain a compound within the scope of the present claims.

Because the Examiner has failed to explain which of the compounds disclosed in the '114 publication are "homologs, isomers, or close structural analogs" of specific compounds within the scope of the claims, Applicants assume that the Examiner is referring to the disclosure in the '114 publication of esters of linolenic

acid with 1,3-propanediol as a plant growth regulant. As Applicants have previously explained, and as is stated in the attached Declaration of Dr. Michael Winther, the term "linolenic acid" used in the '114 publication does not refer to the gamma-linolenic acid recited in the present claims, but rather to alpha-linolenic acid. Dr. Winther also points out that, because of the differences in structure, gamma-linolenic acid is beyond the delta-6-desaturase conversion of fatty acids in the body, while alpha-linolenic acid is not.

The compounds thus have not only differences in structure, but also differences biochemical properties, so that a worker of ordinary skill in the art would not have been motivated to substitute gamma-linolenic acid for alpha-linolenic acid in a plant growth regulant with any reasonable expectation of success.

In addition, as Dr. Winther points out, at least one of the compounds falling within the scope of the claims has unexpectedly superior oral bioavailability, making the compound superior for treatment in cancer cachexia. There is no suggestion in the '114 publication that any of the compounds disclosed therein would have any oral bioavailability for treating cachexia, or that they should be used in any way other than as plant growth regulants.

The Declaration of Dr. Winther points out that the Examiner's placement of prior art compounds and the claimed compounds into the same over-broad pigeon hole (e.g., as "analogs" or "homologs" or "isomers") does not, in this art, give rise to a presumption that the compounds possess similar properties. In fact, Dr. Winther's Declaration clearly indicates that just the opposite presumption is correct. Applicants